Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
2003P16318

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature_____ Typed or printed name _____	Application Number 10/577,589	Filed April 27, 2006
	First Named Inventor Andreas Schmidt	
	Art Unit 2431	Examiner Michael R. Vaughan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
   See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
   (Form PTO/SB/96)

☐ attorney or agent of record.
   Registration number _____.

☑ attorney or agent acting under 37 CFR 1.34.

   Registration number if acting under 37 CFR 1.34 ___37,237_____

/Kerry P. Sisselman/
_____
Signature

Kerry P. Sisselman
_____
Typed or printed name

954-925-1100
_____
Telephone number

April 14, 2010
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of ___1___ forms are submitted.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellants' claims are believed to be patentable over the cited art, as follows.

I.   None of the references cited in the Office Action teach or suggest, among other limitation of Appellants' claims, a data provisioning component transmitting information relating to the result of a usability check to a switching component.

Appellants' independent claim 22 recites, among other limitations:

> transmitting, from the data provisioning component to the switching component, information relating to a result of the check on the usability of the encrypted user data object to be transmitted for the first telecommunications terminal;

Appellants' independent claim 46 recites a similar limitation, among others. However, among other limitations, the cited prior art does not teach or suggest the above-quoted limitation of Appellants' claims.

More particularly, pages 3 – 4 of the final Office Action point to page 6 of the **MOSTAFA** reference, lines 21 – 23 and page 19 of the **MOSTAFA** reference, line 5, as allegedly teaching the above-limitation of Appellants' claims. Appellants respectfully disagree.

Rather, the passages of the **MOSTAFA** reference cited in the Office Action are **silent** about any relevant communication **between the MMS server** of **MOSTAFA** (analogized in the Office Action to Appellants' claimed data provisioning component) **and the MMS rely A** of **MOSTAFA** (analogized in the Office Action to Appellants' claimed switching component). In contrast thereto, Appellants' claims require, among other limitations, **a data provisioning component transmitting information relating to the result of a usability check to a switching component.** As such, the **MOSTAFA** reference fails to teach the above-limitation of Appellants' claims. The further references cited in the Office Action do not cure this deficiency of the **MOSTAFA** reference.

II. Encrypting the multimedia message of MOSTAFA, as taught in CHANG, would render the modified device inoperable and unsatisfactory for its intended purpose, in contradiction to M.P.E.P. § 2143.01(V).

Appellants' claims 22 and 46 require that the user data object being checked for usability by the first telecommunications terminal is an encrypted user data object, the content of which is inaccessible to the switching component, due to the encryption. For example, claims 22 and 46 recite, among other limitations:

> …, the switching component **not having access to a content** of the encrypted user data object due to the encryption;

Page 4 of the Office Action acknowledges that **MOSTAFA** does not disclose that the data object is encrypted, but cites the **CHANG** reference as allegedly teaching encryption of a data object, when taken in combination with **MOSTAFA**. However, the teachings of **CHANG** are not combinable with **MOSTAFA** in the manner suggested in the Office Action, because such a combination impermissibly destroys the operability of the **MOSTAFA** reference.

More particularly, M.P.E.P. § 2143.01(V) states, in part:

> V.   THE **PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**
>
> If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Thus, M.P.E.P. § 2143.01(V) states that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Modifying the teachings of **MOSTAFA** to include the encryption of **CHANG** would render the device of **MOSTAFA** unsatisfactory for its intended purpose, and, in fact, completely inoperable.

More particularly, without further differentiation employing the encryption of **CHANG** on the multimedia message of **MOSTAFA** would prevent the relays of **MOSTAFA** from having access to the addressing information identifying the intended recipient of the message, which addressing information is sent as part of the media content of the message of **MOSTAFA**. See, for example, pg. 17 of **MOSTAFA**, lines 5-8 and pg. 7 of **MOSTAFA**, lines 6-7, which describe that, in **MOSTAFA**, **the addressing information for the message recipient is encapsulated within the multimedia message**. Therefore, if the multimedia message of **MOSTAFA** were encrypted, as suggested in the Office Action, the relays of **MOSTAFA** would not be able to determine the address of the intended recipient of the encrypted multimedia message. Consequently, the relays of **MOSTAFA** would **not** be able to address the intended recipient, thus preventing operation of the device taught in Mostafa. Thus, modifying the teachings of **MOSTAFA** to encrypt the multimedia message in accordance with the teachings of **CHANG** renders the device of **MOSTAFA** unsatisfactory for its intended purpose and completely inoperable. Thus, under M.P.E.P. § 2143.01(V), Appellants' claims are **not** obvious over the **MOSTAFA** reference, alone or in any permissible combination with the **CHANG** reference. Put quite simply, modifying the teachings of **MOSTAFA** to encrypt the multimedia messages would destroy the operability of the **MOSTAFA** reference. Further, nothing in the **MOSTAFA** or **CHANG** references would teach or suggest excluding the addressing information from the encapsulated multimedia message specifically taught in **MOSTAFA**. Rather, the exclusion of this information from the multimedia message of **MOSTAFA** would be directly contrary to the teachings of the **MOSTAFA** reference and would clearly only be suggested as the result of impermissible hindsight reconstruction of Appellants' claimed invention.

For the foregoing reasons, among others, the **MOSTAFA** and **CHANG** references are not combinable to render obvious Appellants' claimed invention.

III. The combination of MOSTAFA and KELLERMAN suggested in the Office Action does not teach, but rather, teaches away from,

Appellants' claimed invention requiring, among other things, the transmission from the data provisioning component to the switching component of information relating to a usability check.

Appellants' claims additionally require, among other limitations of Appellants' claims: 1) that the switching component transmits a "request" for checking the usability of the user data object "together with" the "determined" profiles of the capabilities of the first telecommunications terminal to the data provisioning component; **and** 2) that the data provisioning component transmits information relating to the usability check to the switching component. Pages 4 – 5 of the Office Action acknowledge that **MOSTAFA** does not disclose transmitting of a request, by the switching component, together with the "determined" profiles of the capabilities of the first telecommunications terminal to the data provisioning component. Instead, the Office Action points to the **KELLERMAN** reference as allegedly disclosing this feature, in combination with **MOSTAFA.** Appellants respectfully disagree.

More particularly, the **KELLERMAN** reference discloses sending a profile to a server, which, in turn, **reformats (i.e., transcodes) the content of a media channel based on a profile.** In **KELLERMAN,** the server then **sends the transcoded content** to the end-user device which consumes (uses) the content. See, for example, col. 6 of **KELLERMAN,** lines 57-63. However, if the server of **KELLERMAN always reformats the media into a format usable by the end-user device, per col. 6 of KELLERMAN**, there is no need for a further usability check to be provided, or for informing the switching component about the results of a usability check, as required by Appellants' claims. Rather, all media would be usable by the end-user, since **KELLERMAN** teaches reformatting the media so as to be usable by the end-user prior to sending it.

Thus, a combination of **MOSTAFA** and **KELLERMAN,** as suggested in the Office Action, would teach a person of ordinary skill in this art away from Appellants' claimed invention which requires: 1) that the switching component transmits a "request" for checking the usability

of the user data object "together with" the "determined" profiles of
the capabilities of the first telecommunications terminal to the
data provisioning component; **and** 2) that the data provisioning
component transmits information relating to the usability check to
the switching component. Such a usability check has been obviated
by the reformatting performed in the **KELLERMAN** reference. As such,
Appellants' claimed invention is not rendered obvious by the
combination of **MOSTAFA** and **KELLERMAN**.

**IV. Appellants' dependent claims even further distinguish the
claimed invention over the cited art.**

With regard to claims 23, 24, 28, Appellants note that encryption of
the multimedia message of **MOSTAFA** is incompatible with the
operability of the system of **MOSTAFA**, as discussed above.
Therefore, **MOSTAFA**, alone or in any combination, cannot be said to
teach or suggest an encrypted user data object.

With regard to claim 27, the Office Action points to page 20 of
MOSTAFA, line 11 as allegedly disclosing an address containing a
URL. However, the URL mentioned in the cited portion of **MOSTAFA**,
belongs to the notification (see page 20, line 5-11) formed by the
MMS rely (see page 19, lines 16-21). The claim wording, however,
requires that the URL be part of the address contained in the
reference that is received by the switching component.

Further, with regard to claim 29, **MOSTAFA** fails to teach or suggest,
among other things, that the information to the switching component
contains a pointer to a data provisioning component from which a
suitable user data object can be requested. Actually, **MOSTAFA**
teaches that the translation of the component is carried out by that
network entity that also carries out the other method steps. See,
for example, pg. 6 of **MOSTAFA**, lines 15-25 and pg. 7 of **MOSTAFA**,
lines 21-28. According to page 25 of **MOSTAFA**, lines 30-31, this
network entity is the recipient MMS relay. However, it would be
senseless to provide a pointer to the recipient MMS relay pointing
to itself.

-5-